REMARKS

Applicant respectfully requests entry of the included amendments and consideration of the following remarks in response to the final Office Action mailed February 20, 2008 and Advisory Action mailed June 20, 2008. Applicant respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of this response in this response, claims 1, 2, 10, 11, 18 – 20, and 25 – 27 are pending. More specifically, Applicant adds claims 26 – 27 and amends claims 10 – 11, 19 – 20, and 25. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Rejections Under 35 U.S.C. §102(b)

A. Claim 1 is Allowable Over *Appelman*

The final Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 ("*Appelman*"). Applicant respectfully traverses this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 1 recites:

> A method for handling digital messages, the method comprising:
> determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
> ***in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender.***
> ***(Emphasis added)***

Applicant respectfully submits that claim 1 is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a "method for handling digital messages, the method comprising… ***in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an***

IM session with the sender" as recited in claim 1. More specifically, as admitted by the Advisory Action, *Appelman* discloses "<u>by clicking on the person's address</u>, the recipient may send an e-mail message to the person" (<u>emphasis added</u>, column 14, line 30 and FIG. 10). Additionally, *Appelman* discloses a "user may send an instant message to a person in the Mail Contacts list <u>by clicking on that person's screen name</u>" (<u>emphasis added</u>, column 14, line 21). As illustrated in these passages, *Appelman* discloses that a user <u>must click on a person's screen name/address</u> before *Appelman* will facilitate sending any type of message. Further, as illustrated in FIG. 10 of *Appelman*, an IM session is still not initiated until the user selects the "send an instant message" option from the window that is displayed. As sending of a message in *Appelman* occurs in response to a user clicking on a screen name (and then clicking on a "send an instant message option"), *Appelman* <u>cannot</u> disclose "***in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender***" as recited in claim 1. Even more to the point, since this claim element provides a cause-effect relationship, where a determination of presence is automatically followed by launching of an instant messaging session, *Appelman* cannot anticipate this claim.

Further, the final Office Action argues that *Appelman* discloses "monitor[ing] whether a certain user is capable of receiving an instant message" and "automatically configuring an IM communication between an intended recipient of an email message and the sender of the email message" (OA page 2, line 13, citing *Appelman* Abstract). From these passages, the final Office Action argues that *Appelman* must disclose "***in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender***" as recited in claim 1. However, this is simply not an accurate analysis of the cited art or claim 1. First, monitoring whether a user has an IM capability is different than determining whether an email sender is currently present at an IM account. More specifically, IM capability refers to whether a user has the ability to

communicate via an instant messaging protocol. IM presence however, refers to whether a user with an IM capability is present on an instant messaging account. As is clearly evident, these are different.

Second, there is absolutely no nexus between the two passages cited by the final Office Action by which one could conclude that *Appelman* discloses or even suggests "***in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender***" as recited in claim 1. Simply citing two random, unrelated passages to argue that *Appelman* discloses this element clearly fails the anticipation requirement established by 35 U.S.C. §102(b). Consequently, even if the two passages were to disclose this element of claim 1 (which Applicant has clearly shown as not being the case), utilizing the broadest <u>reasonable</u> interpretation of claim 1 and *Appelman*, one could not possibly conclude that *Appelman* intended to disclose this element.

Third, as indicated in the passage "<u>by clicking on the person's address</u>, the recipient may send an e-mail message to the person" (<u>emphasis added</u>, column 14, line 30 and FIG. 10) and "user may send an instant message to a person in the Mail Contacts list <u>by clicking on that person's screen name</u>" (<u>emphasis added</u>, column 14, line 21), *Appelman* clarifies the statements cited by the final Office Action by indicating that an instant message is sent in response to user input. Consequently, even if the two passages cited by the final Office Action disclose this element of claim 1 (which is clearly not the case), these clarifying passages of *Appelman* clearly indicate that the interpretation of *Appelman* provided in the final Office Action is incorrect. As stated in MPEP §2141.02(VI), "[a] prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." Accordingly, taking *Appelman* in its entirety clearly illustrates that the rejection of claim 1 is improper. For at least these reasons, claim 1 is allowable.

B.   Claim 10 is Allowable Over _Appelman_

The final Office Action indicates that claim 10 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 ("_Appelman_"). Applicant respectfully traverses this rejection on the grounds that _Appelman_ does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 10 recites:

> A computer-readable storage medium that includes a program that when executed by a computer performs at least the following:
> determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
> _**in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender.**_
> **_(Emphasis added)_**

Applicant respectfully submits that claim 10 is allowable over the cited art for at least the reason that _Appelman_ fails to disclose, teach, or suggest a "computer-readable storage medium that includes a program that when executed by a computer performs at least the following... **_in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender_**" as recited in claim 10. More specifically, as admitted by the Advisory Action, _Appelman_ discloses "by clicking on the person's address, the recipient may send an e-mail message to the person" (emphasis added, column 14, line 30 and FIG. 10). Additionally, _Appelman_ discloses a "user may send an instant message to a person in the Mail Contacts list by clicking on that person's screen name" (emphasis added, column 14, line 21). As illustrated in these passages, _Appelman_ discloses that a user must click on a person's screen name/address before _Appelman_ will facilitate sending any type of message. Further, as illustrated in FIG. 10 of _Appelman_, an IM session is still not initiated until the user selects the "send an instant message" option from the window that is displayed. As sending of a message in _Appelman_ occurs in

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response to a user clicking on a screen name (and then clicking on a "send an instant message option"), *Appelman* <u>cannot</u> disclose "*in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender*" as recited in claim 10. Even more to the point, since this claim element provides a cause-effect relationship, where a determination of presence is automatically followed by launching of an instant messaging session, *Appelman* cannot anticipate this claim.

Further, the final Office Action argues that *Appelman* discloses "monitor[ing] whether a certain user is capable of receiving an instant message" and "automatically configuring an IM communication between an intended recipient of an email message and the sender of the email message" (OA page 2, line 13, citing *Appelman* Abstract). From these passages, the final Office Action argues that *Appelman* must disclose "*in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender*" as recited in claim 10. However, this is simply not an accurate analysis of the cited art or claim 10. First, monitoring whether a user has an IM capability is different than determining whether an email sender is currently present at an IM account. More specifically, IM capability refers to whether a user has the ability to communicate via an instant messaging protocol. IM presence however, refers to whether a user with an IM capability is present on an instant messaging account. As is clearly evident, these are different.

Second, there is absolutely no nexus between the two passages cited by the final Office Action by which one could conclude that *Appelman* discloses or even suggests "*in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender*" as recited in claim 10. Simply citing two random, unrelated passages to argue that *Appelman* discloses this element clearly fails the anticipation requirement established by 35 U.S.C. §102(b). Consequently, even

if the two passages were to disclose this element of claim 10 (which Applicant has clearly shown as not being the case), utilizing the broadest reasonable interpretation of claim 10 and *Appelman*, one could not possibly conclude that *Appelman* intended to disclose this element.

Third, as indicated in the passage "by clicking on the person's address, the recipient may send an e-mail message to the person" (emphasis added, column 14, line 30 and FIG. 10) and "user may send an instant message to a person in the Mail Contacts list by clicking on that person's screen name" (emphasis added, column 14, line 21), *Appelman* clarifies the statements cited by the final Office Action by indicating that an instant message is sent in response to user input. Consequently, even if the two passages cited by the final Office Action disclose this element of claim 10 (which is clearly not the case), these clarifying passages of *Appelman* clearly indicate that the interpretation of *Appelman* provided in the final Office Action is incorrect. As stated in MPEP §2141.02(VI), "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." Accordingly, taking *Appelman* in its entirety clearly illustrates that the rejection of claim 10 is improper. For at least these reasons, claim 10 is allowable.

C.   Claim 18 is Allowable Over *Appelman*

The final Office Action indicates that claim 18 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 ("*Appelman*"). Applicant respectfully traverses this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 18 recites:

> A system for handling digital messages, the system comprising:
> means for determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and

means for, in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender.
(Emphasis added)

Applicant respectfully submits that claim 18 is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a "system for handling digital messages, the system comprising... *means for, in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender*" as recited in claim 18. More specifically, as admitted by the Advisory Action, *Appelman* discloses "by clicking on the person's address, the recipient may send an e-mail message to the person" (emphasis added, column 14, line 30 and FIG. 10). Additionally, *Appelman* discloses a "user may send an instant message to a person in the Mail Contacts list by clicking on that person's screen name" (emphasis added, column 14, line 21). As illustrated in these passages, *Appelman* discloses that a user must click on a person's screen name/address before *Appelman* will facilitate sending any type of message. Further, as illustrated in FIG. 10 of *Appelman*, an IM session is still not initiated until the user selects the "send an instant message" option from the window that is displayed. As sending of a message in *Appelman* occurs in response to a user clicking on a screen name (and then clicking on a "send an instant message option"), *Appelman* cannot disclose " *means for, in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender*" as recited in claim 18. Even more to the point, since this claim element provides a cause-effect relationship, where a determination of presence is automatically followed by launching of an instant messaging session, *Appelman* cannot anticipate this claim.

Further, the final Office Action argues that *Appelman* discloses "monitor[ing] whether a certain user is capable of receiving an instant message" and "automatically configuring an IM communication between an intended recipient of an email message and the sender of the email

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message" (OA page 2, line 13, citing *Appelman* Abstract). From these passages, the final Office Action argues that *Appelman* must disclose "***means for, in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender***" as recited in claim 18. However, this is simply not an accurate analysis of the cited art or claim 18. First, monitoring whether a user has an IM capability is different than determining whether an email sender is currently present at an IM account. More specifically, IM capability refers to whether a user has the ability to communicate via an instant messaging protocol. IM presence however, refers to whether a user with an IM capability is present on an instant messaging account. As is clearly evident, these are different.

Second, there is absolutely no nexus between the two passages cited by the final Office Action by which one could conclude that *Appelman* discloses or even suggests "***means for, in response to determining that the sender of the received email message is currently present at an IM account, automatically launching an IM session with the sender***" as recited in claim 18. Simply citing two random, unrelated passages to argue that *Appelman* discloses this element clearly fails the anticipation requirement established by 35 U.S.C. §102(b). Consequently, even if the two passages were to disclose this element of claim 18 (which Applicant has clearly shown as not being the case), utilizing the broadest <u>reasonable</u> interpretation of claim 18 and *Appelman*, one could not possibly conclude that *Appelman* intended to disclose this element.

Third, as indicated in the passage "<u>by clicking on the person's address</u>, the recipient may send an e-mail message to the person" (<u>emphasis added</u>, column 14, line 30 and FIG. 10) and "user may send an instant message to a person in the Mail Contacts list <u>by clicking on that person's screen name</u>" (<u>emphasis added</u>, column 14, line 21), *Appelman* clarifies the statements cited by the final Office Action by indicating that an instant message is sent in response to user input. Consequently, even if the two passages cited by the final Office Action

disclose this element of claim 18 (which is clearly not the case), these clarifying passages of

Appelman clearly indicate that the interpretation of *Appelman* provided in the final Office Action

is incorrect. As stated in MPEP §2141.02(VI), "[a] prior art reference must be considered in its

entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983),

cert. denied, 469 U.S. 851 (1984)." Accordingly, taking *Appelman* in its entirety clearly

illustrates that the rejection of claim 18 is improper. For at least these reasons, claim 18 is

allowable.

D. Claim 19 is Allowable Over *Appelman*

The final Office Action indicates that claim 19 stands rejected under 35 U.S.C. §102(b)

as allegedly being anticipated by U.S. Patent Number 6,912,564 ("*Appelman*"). Applicant

respectfully traverses this rejection on the grounds that *Appelman* does not disclose, teach, or

suggest all of the claimed elements. More specifically, claim 19 recites:

> A system for handling digital messages, the system comprising:
> a memory that stores at least the following:
> condition-determination logic that determines whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
> ***launch logic that, in response to determining that the sender of the email message is currently present at an IM account, automatically launches an IM session with the sender.***
> ***(Emphasis added)***

Applicant respectfully submits that claim 19 is allowable over the cited art for at least the

reason that *Appelman* fails to disclose, teach, or suggest a "system for handling digital

messages, the system comprising... ***launch logic that, in response to determining that the***

sender of the email message is currently present at an IM account, automatically

launches an IM session with the sender" as recited in claim 19. More specifically, *Appelman*

discloses "by clicking on the person's address, the recipient may send an e-mail message to the

person" (column 14, line 30 and FIG. 10). Additionally, *Appelman* discloses a "user may send an instant message to a person in the Mail Contacts list by clicking on that person's screen name" (column 14, line 21). As illustrated in these passages, *Appelman* discloses that a user must click on a person's screen name/address before *Appelman* will facilitate sending any type of message. Further, as illustrated in FIG. 10 of *Appelman*, an IM session is still not initiated until the user selects the "send an instant message" option from the window that is displayed. As sending of a message in *Appelman* occurs in response to a user clicking on a screen name (and then clicking on a "send an instant message option"), *Appelman* <u>cannot</u> disclose " *launch logic that, in response to determining that the sender of the email message is currently present at an IM account, automatically launches an IM session with the sender*" as recited in claim 19.

Further, the final Office Action argues that *Appelman* discloses "monitor[ing] whether a certain user is capable of receiving an instant message" and "automatically configuring an IM communication between an intended recipient of an email message and the sender of the email message" (OA page 2, line 13, citing *Appelman* Abstract) and consequently, according to the final Office Action argument, discloses "*launch logic that, in response to determining that the sender of the email message is currently present at an IM account, automatically launches an IM session with the sender*" as recited in claim 19. However, this is simply not an accurate analysis of the cited art or claim 19. First, monitoring whether a user has an IM capability is different than determining whether an email sender is currently present at an IM account. Second, there is absolutely no nexus between the two passages cited by the final Office Action by which one could conclude that *Appelman* discloses or even suggests "*launch logic that, in response to determining that the sender of the email message is currently present at an IM account, automatically launches an IM session with the sender*" as recited in claim 19. Third, as indicated by the passage cited by Applicant above, *Appelman* clarifies the statements cited by the final Office Action by indicating that "user may send an

instant message to a person in the Mail Contacts list <u>by clicking on that person's screen name</u>"

(<u>emphasis added</u> column 14, line 21). For at least these reasons, claim 19 is allowable.

E. <u>Claim 25 is Allowable Over *Appelman*</u>

The final Office Action indicates that claim 25 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 ("*Appelman*"). Applicant respectfully traverses this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 25 recites:

> A system for handling digital messages, the system comprising:
> a memory that stores at least the following:
> condition-determination logic that determines whether a sender of a received digital message is currently present at an Instant Messaging (IM) account;
> ***launch logic that, in response to determining that the sender of the received digital message is currently present at an IM account, automatically launches an IM session with the sender.***
> *(Emphasis added)*

Applicant respectfully submits that claim 25 is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a "system for handling digital messages, the system comprising... ***launch logic that, in response to determining that the sender of the received digital message is currently present at an IM account, automatically launches an IM session with the sender***" as recited in claim 25. More specifically, *Appelman* discloses "by clicking on the person's address, the recipient may send an e-mail message to the person" (column 14, line 30 and FIG. 10). Additionally, *Appelman* discloses a "user may send an instant message to a person in the Mail Contacts list by clicking on that person's screen name" (column 14, line 21). As illustrated in these passages, *Appelman* discloses that a user must click on a person's screen name/address before *Appelman* will facilitate sending any type of message. Further, as illustrated in FIG. 10 of *Appelman*, an IM session is still not initiated until the user selects the "send an instant message"

option from the window that is displayed. As sending of a message in *Appelman* occurs in response to a user clicking on a screen name (and then clicking on a "send an instant message option"), *Appelman* <u>cannot</u> disclose "***launch logic that, in response to determining that the sender of the received digital message is currently present at an IM account, automatically launches an IM session with the sender***" as recited in claim 25.

Further, the final Office Action argues that *Appelman* discloses "monitor[ing] whether a certain user is capable of receiving an instant message" and "automatically configuring an IM communication between an intended recipient of an email message and the sender of the email message" (OA page 2, line 13, citing *Appelman* Abstract) and consequently, according to the final Office Action argument, discloses "***launch logic that, in response to determining that the sender of the received digital message is currently present at an IM account, automatically launches an IM session with the sender***" as recited in claim 25. However, this is simply not an accurate analysis of the cited art or claim 25. First, monitoring whether a user has an IM capability is different than determining whether an email sender is currently present at an IM account. Second, there is absolutely no nexus between the two passages cited by the final Office Action by which one could conclude that *Appelman* discloses or even suggests "***launch logic that, in response to determining that the sender of the received digital message is currently present at an IM account, automatically launches an IM session with the sender***" as recited in claim 25. Third, as indicated by the passage cited by Applicant above, *Appelman* clarifies the statements cited by the final Office Action by indicating that "user may send an instant message to a person in the Mail Contacts list <u>by clicking on that person's screen name</u>" (<u>emphasis added</u> column 14, line 21). For at least these reasons, claim 25 is allowable.

F.   <u>Claims 2, 11, and 20 are Allowable Over *Appelman*</u>

The final Office Action indicates that claims 2, 11, and 20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 ("*Appelman*"). Applicant respectfully traverses this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claim 2 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 1. Dependent claim 11 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 10. Further, dependent claim 20 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 19. *In re Fine*, *Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

II.   New Claims 26 – 27 are Allowable

In addition, Applicant adds new claims 26 – 27. New claim 26 is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a "computer-readable medium for handling digital messages, the computer-readable medium including a program that when executed by a computer performs at least the following… ***in response to determining that the sender of the email message is currently present at an IM account, automatically, without user input, launching an IM session with the sender*** *(emphasis added)*, as recited in claim 26. Additionally, new claim 27 is allowable as a matter of law for at least the reason that this claim depends from allowable independent claim 26. *In re Fine*, *Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the final Office Action and/or Advisory Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the final Office Action and/or Advisory Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

_____/afb/_____
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